

REMARKS

Claims 1 to 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wachtfogel et al. (U.S. Patent Publication No. 2002/0138831) in view of Wolf et al. (U.S. Patent Publication No. 2003/0083932).

The rejection is in error for the following reasons.

The Examiner is reminded of the applicant's claimed foreign priority date of August 23, 2000. Further, to perfect the priority claim, the applicant has already submitted a verified translation of the priority document, Japanese Application No. 2000-252004, in the response filed on June 30, 2004.

The cited reference to Wolf et al. is relied on in the current Office Action solely for the subject matter disclosed in paragraph [0048]. In particular, the Examiner has alleged that, in paragraph [0048], Wolf et al. teaches the claimed concept "wherein advertisements are arranged into more specific geographic areas by categorizing the advertisements so as to belong to respective levels of geographic fractionalization within said multi-level storage hierarchy, categorizing the advertisements according to area sections within said respective levels, and categorizing the advertisements according to the content thereof." (Office Action, page 3, line 16, to page 4, line 4.)

Initially, the applicant certainly does not concede that Wolf et al. actually discloses that which the Examiner alleges it does. Wolf et al. discloses a system by which advertisements are printed on employee pay stubs, and the indicated paragraph of

Wolf et al. merely discusses ways in which data for advertisers can be categorized by means of demographics, psychographics or geographics. There is no disclosure whatsoever of a storing means comprising a multi-level storage hierarchy for storing advertisements, in which the levels of the multi-level storage hierarchy gradually fractionalize advertisement areas into increasingly more specific geographic regions, as precisely claimed. Even further, the more detailed features of the first through fourth levels making up the multi-level storage means set forth in claim 13 (i.e., a first level divided into country area sections, a second level sub-divided into major area sections such as states or provinces, a third level further sub-divided into county or prefecture area sections, and a fourth level further sub-divided into city or municipality area sections) are, by no means, disclosed or suggested in the cited reference.

However, most significantly, the subject matter discussed in paragraph [0048] of Wolf et al. is not supported by Provisional Application No. 60/181,611 and therefore this subject matter cannot be relied upon to reject the pending claims. A reading of the entire 10 page provisional application (attached herewith) reveals that the provisional application includes no discussion whatsoever of the subject matter appearing in paragraph [0048] of the formal non-provisional patent application filed on February 12, 2001.

Further, the provisional application has no subject matter even resembling or marginally relating to the claimed features of a storing means comprising a multi-level storage hierarchy for

storing advertisements, in which the levels of the multi-level storage hierarchy gradually fractionalize advertisement areas into increasingly more specific geographic regions, or of any means for categorizing the advertisements so as to belong to respective levels of geographic fractionalization within said multi-level storage hierarchy, categorizing the advertisements according to area sections within said respective levels, and categorizing the advertisements according to the content thereof, as specifically claimed.

The 35 U.S.C. § 102(e) critical reference date of a U.S. application publication is the filing date of the provisional application *only if* the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. See, Manual of Patent Examining Procedure, MPEP § 2136.03 III.

In the present case, as noted above, the subject matter relied upon to make the rejection (i.e., paragraph [0048] of Wolf et al.) is not properly supported by the provisional application, and therefore, for purposes of this rejection, the Examiner cannot use the February 10, 2000 filing date of the provisional application. In other words, the subject matter in paragraph [0048] would be citable only as of the filing date of the U.S. non-provisional application itself, or February 12, 2001.

Accordingly, the perfected priority date of August 23, 2000 of the present application antedates the earliest effective and applicable date for which the applied subject matter in the cited reference can be relied upon. Therefore, it is respectfully

submitted that Wolf et al., for purposes of the subject matter relied upon to make the rejection, must be removed as an applicable reference in light of the applicant's priority date.

Since the subject matter relied upon to make the rejection is not citable as prior art, and the provisional application clearly does not disclose the subject matter of the pending claims, it is respectfully submitted that the rejection is improper and should be withdrawn.

The Examiner has already acknowledged that the primary reference, Wachtfogel et al., fails to disclose the claimed storage means, comprising a multilevel storage hierarchy in which the levels thereof gradually fractionalize advertisement areas into *increasingly more specific geographic regions*, as currently claimed. Moreover, as the Examiner has similarly acknowledged, Wachtfogel et al. also fails to disclose or suggest any means for categorizing advertisements so as to belong to respective levels of geographic fractionalization within the multi-level storage hierarchy, categorizing the advertisements according to area sections within the respective levels, and categorizing the advertisements according to the content thereof. Any citable subject matter from Wolf et al., insofar as being properly supported by the provisional application, clearly cannot make up for the admitted deficiencies of Wachtfogel et al.

In closing, the applicant respectfully points out that numerous efforts have been taken to explain the essential concepts of the invention, the basic features of which are shown in FIG. 2 and other drawings of the present specification. The

Examiner is requested to carefully reconsider the explanations of the invention given in the previous response to the Final Office Action, submitted on December 13, 2004, with particular attention to the explanations on page 10, line 15, though page 11, line 20, which are incorporated into the present response by reference. Once again, the applicant urges that no reference has been cited, which suggests a "storing means comprising a multi-level storage hierarchy for storing advertisements, in which the levels of said multi-level storage hierarchy gradually fractionalize advertisement areas into increasingly more specific geographic regions," or any "means for categorizing the advertisements so as to belong to respective levels of geographic fractionalization within said multi-level storage hierarchy, categorizing the advertisements according to area sections within said respective levels, and categorizing the advertisements according to the content thereof," as presently claimed.

To date, to supplement the admitted deficiencies of Wachtfogel et al., the Examiner has conducted additional searching at least three times, and has attempted various combinations of teachings using three different secondary references. In each case, strong arguments traversing such combinations have been presented. It is difficult to believe that additional searching or citing of other references would be of further benefit, or achieve that which, so far, the Examiner has not been able to show. Accordingly, it is respectfully requested that the applicant either be permitted to proceed to appeal on the basis of the current record, or that the Examiner

please withdraw the current rejections and pass this application to allowance.

For the foregoing reasons, it is respectfully submitted that claims 1 to 13 would not have been obvious to a person skilled in the art at the time the present invention was made. Accordingly, withdrawal of the rejection and allowance of claims 1 to 13 is hereby respectfully requested.

No fees are due with this paper. Notwithstanding, should it be deemed that any fees, or deficiencies in fees, are due with this or any accompanying communication, authorization is given to charge such fees to the Attorney's Deposit Account No. 07-2519.

Respectfully submitted,



Paul A. Guss
Reg. No. 33,099
Attorney for Applicants

CS-37-010822

775 S. 23rd St. #2
Arlington, VA 22202
Tel. 703-486-2710